

Application No. 10/650,553

REMARKS

With respect to the rejection of Claims 2, 3, 9 and 11 under 35 U.S.C. 112, second paragraph, reference page 2, paragraph 2, of the Official Action, this rejection is respectfully traversed, especially since the claims are directed to one of ordinary skill in the art. Nevertheless, Claims 9 and 11 have been clarified in accordance with the Examiner's suggestions. With respect to Claims 2 and 3, they appear to be in the proper form, it being noted that Claim 3 does recite the low molecular weight as being from about 1,000 to about 25,000 in weight average molecular weight.

The rejection of Claims 1 to 5 and 13 to 36 under 35 U.S.C. 102(b) as being anticipated by Mahabadi et al. 5,229,242 is respectfully traversed. For a 102 rejection to be valid, each and every feature of the claimed invention must be pointed out by the Examiner in the disclosure, however, to advance and expedite prosecution, Applicants have clarified Claim 1 by incorporating the subject matter thereof of Claim 6. Since Claim 6 was not part of the 35 U.S.C. 102 rejection, it is believed that this rejection is no longer applicable.

The rejection of Claims 1 to 38 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,538,063 is respectfully traversed.

The Mahabadi et al. 5,229,242 reference is not believed to be relevant in view of the comments provided hereinbefore. With respect to the '063 patent, it is directed to a resin which contains a polymer blend of a polystyrene based polymer component and a petroleum resin based polymer component, it being noted that the petroleum polymer component possesses a number of characteristics including that when the petroleum resin based polymer forms a resin composition with the polystyrene based polymer at a ratio of, for example, one to one there results certain characteristics, such as a light transmission characteristics, for example see Claim 1 of the '063 patent. The Examiner has not established that this reference relates to a

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toner which contains two different types of polymers, namely a resin and the compatibilizer, see Claim 1, there being no reaction or formation of a copolymer between such resin, and where such compatibilizer is apparently being suggested by the Examiner. The Examiner is requested to again consider the '063 patent, note the columns referred to by the Examiner, namely columns 4 and 6, also note, for example, column 10 wherein it is clearly indicated that a copolymerization is being accomplished to form one copolymer, and wherein it is indicated that the weight average molecular weight of the component B, the mixing ratio, and the like are of importance with respect to forming the copolymer, see column 10. Additionally, the Examiner is referred to column 12 wherein in addition to the copolymer there is selected a thermoplastic resin. Also, the Examiner is referred to column 15, category II, second invention, wherein it is indicated that the substantially transparent resin comprises a polystyrene type polymer and a petroleum based polymer wherein the petroleum resin polymer forms a resin composition with the polystyrene type polymer. Certain characteristics are disclosed in the '063 patent with respect to the petroleum resin, see for example column 17. Moreover, the Examiner is referred to the synthesis in lab Examples beginning on page 28 which supports Applicants' position that a copolymer is being generated as illustrated herein. Additionally, of interest are the Comparative Examples beginning in column 33 wherein small changes result in undesirable characteristics as illustrated in column 1. For example, in Comparative Example I-1 when the amount of hydrogenated resin used as component A was changed to 100 grams and a polystyrene component B was not used, the results shown in Table 1 for such a copolymer were not satisfactory according to the '063 patent. This indicates the unpredictability, and that perhaps undue experimentation would be needed for one of ordinary skill in the art to arrive at the invention of the present application, particularly without the benefit of the teachings thereof.

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Concerning the combination with the Mahabadi et al. reference, it is not believed that such a combination is necessarily achievable to one of ordinary skill in the art even though both references disclose a toner since the resin of the '242 patent, that is the compatibilizer, is a block or graft copolymer together with a toner resin, and the Examiner has pointed to no teachings in the '063 patent with respect to a toner containing a compatibilizer.

Accordingly, it is respectfully urged that the Examiner reconsider his positions and submit to Applicants a Notice of Allowance.

In the event the Examiner considers personal contact advantageous to the disposition of this case, he/she is hereby requested to call Eugene O. Palazzo, at Telephone Number 585-423-4687, Rochester, New York.

Respectfully submitted,



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